REMARKS

Claim 1 has been amended to clarify that the initial rodent is transgenic for an expression system which contains the nucleotide sequence encoding a fluorescent protein operably linked to a promoter that is active in all cells of said rodent. As pointed out previously, this is supported by the examples wherein the β actin promoter is employed; this is a promoter that is active in all cells without induction. While not explicitly stated in the specification in its generic form, because expression in all tissues is required, this type of promoter is an inevitable requirement. Thus, no new matter has been added.

The document applied by the Office in rejecting the claims, Kern (WO 02/28188) is clearly inadequate to anticipate the claims as presently drawn. First, there is no articulated assertion in Kern that all tissues of the transgenic mice described will produce the GFP described in that specification. Nowhere does Kern say the GFP is expressed in all tissues.

Second, Kern fails to disclose that it is necessary to employ a promoter that is expressed and active in all cells. Constituitive promoters are referred to, but as noted above, many constituitive promoters are tissue-specific. Thus, the designation of a promoter as constituitive does not lead inevitably to the production of the rodents as presently claimed. In addition, unlike the present application, Kern does not adequately describe how to obtain rodents having the characteristics of those in the present claims, even in Kern's example 1 which relates to a transgenic mouse having a selectable thymidine kinase gene. There is no description of how the breeding set forth in the last sentence on page 15 would be conducted. As to a description of how to acquire a completely "green" mouse, example 3 is clearly inadequate.

The purpose of the creation of the transgenic animals as described by Kern is to permit the cells of the transgenic animal to be distinguished from tumor cells. Thus, there is no necessity for the transgenic mice to express the fluorescent protein in all cells. The mice need only express the fluorescent proteins in the tissues associated with, for example, a transplanted tumor.

In the Advisory Action, the Office asserts that the burden is on the applicant to demonstrate that the cited document does not inherently possess the characteristics of the claimed subject matter. Respectfully, there is insufficient information provided in the cited document to permit applicants to reproduce the procedures described in Kern. The burden being transferred to the applicant may be appropriate when the cited document actually describes a particular process for producing what may turn out to be the claimed subject matter. Here, this is not the case. There is no description in Kern that would permit applicants to follow the procedures of Kern to demonstrate a difference; Kern is simply not enabling with regard to the invention as claimed.

In view of this, reconsideration of the rejection over Kern is respectfully requested.

With respect to the Supplementary Information Disclosure Statement filed on 28 November 2007, applicants apologize for the confusion. It is unnecessary for the Office to consider the documents cited as the U.S. counterpart of the Japanese application set forth on that IDS is already of record. The relevant document, U.S. 2002/0026649, is highlighted on the attached exhibit.

Applicants respectfully request reconsideration of the rejection and passage of claims 1-3 and 21 to issue and rejoinder of claims 19-20.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 312762004400.

Respectfully submitted,

Dated: January 28, 2008

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Inventor: see Assignee

Assignee: None

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Priority Number: 1997-04-28 US1997000848539
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Designated Country: AL AM AP AZ BA BB BG BR BY CA CU CZ EA EE GE HU IL IS JP KE KG KP KR KZ AT BE CH CY DE DK ES FI FR GB GR IE IT

Family:

PDF	Publication	Pub. Date	Filed	Title
	WO9849336A1	1998-11-05	1998-04-28	METASTASIS MODELS USING GRI FLUORESCENT PROTEIN (GFP) A MARKER
	WO0040274A1	2000-07-13	2000-01-07	METASTASIS MODELS USING GRI FLUORESCENT PROTEIN (GFP) A MARKER
	US20040191173A1	2004-09-30	2004-04-06	Metastasis models using green fluore protein (GFP) as a marker
	US20020026649A1	2002-02-28	2001-05-29	Metastasis models using green fluore protein (GFP) as a marker
	US20020006102A1	2002-01-17	2001-08-03	Near field magneto-optical head havi and write pinhole apertures
	US6759038	2004-07-06	2001-05-29	Metastasis models using green fluore protein (GFP) as a marker
	US6545970	2003-04-08	2001-08-03	Near field magneto-optical head havi and write pinhole apertures

Exhibit 1

	US6324129B1	2001-11-27		
	US6324129	2001-11-27	1999-01-07	Near field magneto-optical head havi and write pinhole apertures
	US6251384	2001-06-26	1999-01-07	Metastasis models using green fluore protein (GFP) as a marker
	US6235968	2001-05-22	1998-04-28	Metastasis models using green fluore protein (GFP) as a marker
	US6235967	2001-05-22	1998-03-27	Metastasis models using green fluore protein as a marker
	US6232523	2001-05-15	1997-04-28	Metastasis models using green fluore protein (GFP) as a marker
	JP2005006660A2	2005-01-13	2004-08-24	METASTASIS MODEL USING GRE FLUORESCENT PROTEIN (GFP) A
	JP2002534398T2	2002-10-15	2000-01-07	
	JP2001517090T2	2001-10-02	1998-04-28	
	EP1156833A1	2001-11-28	2000-01-07	METASTASIS MODELS USING GR FLUORESCENT PROTEIN (GFP) A MARKER
	EP0979298A1	2000-02-16	1998-04-28	METASTASIS MODELS USING GR FLUORESCENT PROTEIN (GFP) A MARKER
	CN1264429T	2000-08-23	1998-04-28	Metastasis models using green fluore protein (GFP) as marker
	CN1264429A	2000-08-23	1998-04-28	Metastasis models using green fluore protein (GFP) as marker
	CA2358439AA	2000-07-13	2000-01-07	METASTASIS MODELS USING GR FLUORESCENT PROTEIN (GFP) A AMARKER
	CA2289283AA	1998-11-05	1998-04-28	METASTASIS MODELS USING GR FLUORESCENT PROTEIN (GFP) A MARKER
	AU7164898A1	1998-11-24	1998-04-28	METASTASIS MODELS USING GR FLUORESCENT PROTEIN (GFP) A MARKER
	AU0749338B2	2002-06-27	1998-04-28	METASTASIS MODELS USING GR FLUORESCENT PROTEIN (GFP) A MARKER
	AU0024069A5	2000-07-24	2000-01-07	METASTASIS MODELS USING GR FLUORESCENT PROTEIN (GFP) A MARKER

25 family members shown above

Forward References: **Go to Result Set:** Forward references (1)

PDF	Patent	Pub.Date	Inventor	Assignee	Title
	US7280680	2007-10-09	Yokota; Hideo	Riken	Method and apparatus for observing dimensional localizations of in vivo genes as well as method and appar observing minute three-dimensional localizations of in vivo expressed ge

Other Abstract CHEMABS 129(26)340515R DERABS C1999-009442